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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|-------------------------------|
| In re Patent Application of: |) | Group Art Unit: 1634 |
| |) | |
| ADAMS <i>et al.</i> |) | Examiner: Chakrabarti, A. |
| |) | |
| Serial No. 09/867,193 |) | Atty. Docket No. GP100-03.CN1 |
| |) | |
| Filed: May 29, 2001 |) | VIA FACSIMILE |
| |) | |
| For: DECOY PROBES |) | |

REPLY UNDER 37 C.F.R. § 1.111

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Examiner's Office Action mailed on February 13, 2002, kindly enter the following amendments and consider the following remarks in connection with the above-captioned application.

Amendments

IN THE SPECIFICATION:

Kindly substitute the following for page 1, lines 5-6, of the specification:

bi
This application is a continuation of application Serial No. 09/365,121, filed July 30, 1999, now U.S. Patent No. 6,297,365, the contents of which are hereby incorporated by reference herein, which claims the benefit of U.S. Provisional Application No. 60/094,979, filed July 31, 1998.

* * * * *

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Remarks

Claims 1-18, 34 and 35 are presently pending in the subject application.

Reconsideration and allowance in view of the above amendments and the following remarks are respectfully requested.

The specification has been amended herein to update the continuing data. A marked-up copy of the amendments to the specification is being provided herewith in accordance with the provisions set forth in 37 C.F.R. § 121.

Double Patenting Rejection

Claims 1-18 stand rejected by the Examiner under 35 U.S.C. § 101 for statutory double patenting over claims 1-18 of U.S. Patent No. 6,297,365 ("the '365 patent"). Specifically, the Examiner contends that claims 1-18 of the instant application are identical to claims 1-18 of the '365 patent. Applicants respectfully traverse this rejection for the reasons that follow.

In their Preliminary Amendment dated May 29, 2001, Applicants stressed that while the claims of the instant application and the claims of the '365 patent are directed to overlapping subject matter, the claims of the instant application are not directed to the "same invention" as the claims of the '365 patent. For that reason, Applicants submitted at that time that it would be inappropriate for the Examiner to issue a same invention rejection in this case. *See* MPEP § 804 II.A. at 800-20 (8th ed., August 2001) ("A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent."). The Examiner disagreed, arguing that claims 1-18 of the instant application are "exactly identical" to claims 1-18 of the '365 patent.

In making this determination, the Examiner appears to have concluded that the second nucleotide base sequence region of claim 1 of the '365 patent is optional. It is not. First, there is no antecedent basis in claim 1 of the '365 patent for the "optionally present" language. Second, an

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interpretation that the second nucleotide base sequence region in claim 1 of the '365 patent is an optional feature is inconsistent with the prosecution history of application Serial No. 09/365,121 ("the '121 application"), the application which ultimately issued as the '365 patent. This is evident from an Interview Summary in the '121 application, in which the Examiner commented as follows:

Applicant was advised to delete the "optional second region" language from independent claims 1 and 11 to disclose the novelty of the invention more clearly. Applicant agreed to the advise . . . Applicant was informed about the allowability of all pending claims in this application.

See Exhibit 1, Attachment B. A Notice of Allowability was then mailed to Applicants on May 14, 2001, and an Examiner's Amendment was included which amended claim 1 as follows:

Claim 1 has been amended by deleting the phrase -- an optionally present second nucleotide base recognition sequence region, provided that if said region is nucleic acid, then second region is either directly joined -- and by inserting the phrase --> a second nucleotide base recognition sequence region joined directly.

...
Claim 11 has been amended by deleting the phrase -- an optionally present second nucleotide base recognition sequence region, provided that if said region is nucleic acid, then second region is either directly joined -- and by inserting the phrase --> a second nucleotide base recognition sequence region joined directly.

See Exhibit 1, Attachment C. The Examiner's amendment to claims 1 and 11 removed the "optional" aspect of the second nucleotide sequence region, thus evidencing that the "optionally present" language in line 8 of claim 1 and in line 9 of claim 11 was an obvious clerical error. Applicants note that the wording of the amended claims should have been fully consistent with that authorized by Applicants' representative in a Draft Supplemental Response to Final Action sent by facsimile to the Examiner on May 3, 2001. See Exhibit 1, Attachment A.

On May 29, 2001, the same day that Applicants paid the issue fee due in the '121 application, Applicants filed an Amendment Under 37 C.F.R. § 1.312 to correct the Examiner's

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errors in amended claims 1 and 11, as well as other claims. *See* Exhibit 1, Attachment D. This Section 312 Amendment was not considered by the Examiner prior to issuance of the '365 patent.

A Request for Certificate of Correction Under 35 U.S.C. §254 Pursuant to 37 C.F.R. § 1.322 was subsequently filed on October 12, 2001, ten days after the '365 patent issued, to correct errors in the issued claims resulting from the Examiner's incomplete Examiner's Amendment. *See* Exhibit 1. As Applicants noted in the second paragraph on page 2 of this Request for Certificate of Correction, "Patentee substituted claims which excluded the 'wherein' clause which had appeared in claims 1 and 11, as the wherein clause was nonsensical given the Examiner's removal of the 'optionally present second nucleotide base sequence region' language from these claims." As Applicants pointed out in the same paragraph, "the claim amendments [of their Section 312 Amendment] were intended to render the claim language consistent with those amendments which were to be made by the Examiner pursuant to Patentee's authorization."

For the preceding reasons, Applicants submit that claims 1 and 11 of the '365 patent must be interpreted as including the recited second nucleotide base sequence region. Claim 1 of the instant application, however, provides that the second nucleotide base sequence region is optional unless the first nucleotide base sequence region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide. Thus, it is indisputable that there are embodiments of the invention falling inside the scope of present claim 1 which fall outside the scope of claim 1 of the '365 patent. Therefore, the Examiner's statutory double patenting rejection is clearly improper and, accordingly, its withdrawal is hereby respectfully requested.

Should the Examiner contemplate replacing the statutory double patenting rejection with an obviousness-type double patenting rejection, Applicants submit that the Terminal Disclaimer Under 37 C.F.R. § 1.321 filed herewith is sufficient to overcome such a rejection. Accordingly, any double patenting rejection in view of the '365 patent is deemed improper by Applicants.

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Claims 34 and 35 stand rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11, respectively, of U.S. Patent No. 6,297,365 in view of Stackebrandt *et al.* (U.S. Patent No. 5,089,386). Without addressing the merits of the Examiner's argument, Applicants submit that this rejection is overcome by the Terminal Disclaimer filed herewith. Accordingly, withdrawal of this rejection is hereby respectfully requested.

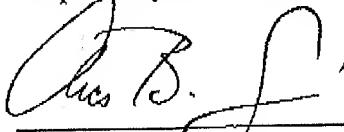
Conclusion

Applicants submit that the subject application is in condition for allowance and Notice to that effect is respectfully requested.

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 703-872-9306 on the date indicated below to Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C. 20231.

Respectfully Submitted,



Date: February 21, 2002

By:

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MARKED-UP COPY OF AMENDMENTS

IN THE SPECIFICATION:

The specification has been amended at page 1, lines 5-6, as follows:

This application is a continuation of application Serial No. 09/365,121, filed July 30, 1999, now U.S. Patent No. 6,297,365, the contents of which are hereby incorporated by reference herein, which claims the benefit of U.S. Provisional Application No. 60/094,979, filed July 31, 1998.

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EXHIBIT 1

CERTIFICATE OF CORRECTION

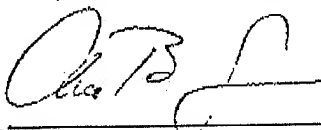
Patent No. US 6,297,365 B1 / Serial No. 09/365,121
Atty. Docket No. GP100-02.UT

interview with the Examiner and subsequently requested in Patentee's Section 312 Amendment. As discussed above, such correction would not introduce new matter or raise new issues. Accordingly, entry of the requested certificate of correction is hereby respectfully requested.

No fee is believed due in connection with this request. If Patentee is mistaken, please charge the amount due to Deposit Account No. 07-0835.

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being deposited on the date indicated below with the U.S. Postal Service as first class mail addressed to the Certificate of Correction Branch, Commissioner for Patents, Washington, D.C. 20231

Respectfully submitted,



Date: October 12, 2001

By:

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Attachment A